LEXSEE 2006 U.S. DIST. LEXIS 94329

Boston Scientific Corp. and Target Therapeutics, Inc., Plaintiffs, v. Cordis Corp., Defendant.

NO. C 02-01474 JW

UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA, SAN JOSE DIVISION

2006 U.S. Dist. LEXIS 94329

December 20, 2006, Decided
December 20, 2006, Filed

PRIOR HISTORY: *Boston Sci. Corp. v. Cordis Corp., 2006 U.S. Dist. LEXIS 63141 (N.D. Cal., Aug. 21, 2006)*

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For Boston Scientific Corporation, Target Therapeutics, Inc., Counter-defendants: Patrick S. Thompson, Goodwin Procter LLP., LEAD ATTORNEY, San Francisco, **[*2]** CA.; Amanda Marie Kessel, Goodwin Procter, LLP, Boston, MA.; Julie Lynn Fieber, Folger Levin & Kahn LLP, San Francisco, CA.

JUDGES: JAMES WARE, United States District Judge.

OPINION BY: JAMES WARE

OPINION

SUPPLEMENTAL CLAIM CONSTRUCTION ORDER

I. INTRODUCTION

On December 5, 2006, the Court conducted a hearing in accordance with *Markman v. Westview Instruments, Inc., 517 U.S. 370, 116 S. Ct. 1384, 134 L. Ed. 2d 577 (1996)*, to construe an additional phrase which is used in Claims 3 and 9 of *U.S. Patent No. 6,010,498* patent ("the *'498 Patent"*) and Claims 8 and 33 of *U.S. Patent No. 5,895,385* ("the *'385 Patent*"). This Order sets forth the Court's construction of the phrases at issue.

II. DISCUSSION

A. *Claim Term in Dispute: "adapted to"*

Claim 3 of the *'498* Patent provides:

> The combination of claim 1 wherein said detachable elongate tip portion is a long and substantially pliable segment **adapted to** be multiply folded upon itself to substantially pack said body cavity.

('*498* Patent, Col. 13:15-18.)

The parties dispute the proper construction of the phrase "adapted to." Similar use of the phrase "adapted to" appears in Claim 9 of the '*498* Patent and Claims **[*3]** 8 and 33 of the *'385 Patent*. For example, Claim 8 provides:

> The improvement of claim 7 wherein said elongate distal tip is a long and substantially pliable segment **adapted to** be multiply folded upon itself to sufficiently occupy said body cavity to impede fluid flow therein.

('*385 Patent*, Col. 13:40-43.)

B. Principles of Claim Construction

A principle of patent claim construction is that the words of a claim are to be given their ordinary and customary meaning, which is the meaning that the words would have to a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp., 415 F.3d 1303, 1312-13 (Fed. Cir. 2005)*. A person skilled in the art is deemed to have read the claims and written description and to have knowledge of any special meaning and usage of the words used in the claims. *Id. at 1313*. Thus, in the claim construction process, the Court should start by reviewing these same resources to derive definitions for the words and phrases in the claims. *Id.*

C. Proposed Definitions

Both parties contend that the phrase "adapted to" is an ordinary and customary phrase and **[*4]** should be given its ordinary and customary meaning. (*See* Plaintiffs' Brief Regarding Claim Construction of the "Adapted To" Claim Term, "Pls.' Br.," Docket Item No. 930, at 3; Defendant's Brief in Support of Claim Construction of the Phrase "Adapted To," "Def.'s Br.," Docket Item No. 931, at 2.) However, they proffer different meanings for the phrase both based on dictionary definitions.

Plaintiffs Boston Scientific Corp. and Target Therapeutics, Inc. contend that "adapted to" should be construed to mean **"configured to"** to convey that the elongate tip portion was designed (i.e., configured) to multiply fold upon itself. (Pls.' Br. at 3.) Defendant Cordis Corp. ("Defendant") contends that the term should be construed to mean **"suitable for"** because that is the plain and ordinary meaning of "adapted to." (Def.'s Br. at 1.)

D. Construction of Phrase

In accordance with the principles of claim construction articulated in *Phillips,* the Court turns first to the intrinsic evidence to construe the phrase "adapted to."

Claim 7 of the *'385 Patent* discloses an elongate distal tip "capable of" [1] being multiply folded upon itself:

> An apparatus for use **[*5]** in occluding a body cavity comprising: ... a detachable elongate distal coupled to said wire, said elongate distal tip being a relaxed coil **capable of** being multiply folded upon itself.

('*385 Patent*, Col. 13:33-39.) Claim 8, which depends from Claim 7, claims an elongate distal tip "adapted to" be multiply folded upon itself:

> The improvement of claim 7 wherein said elongate distal tip is a long and substantially pliable segment **adapted to** be multiply folded upon itself to sufficiently occupy said body cavity to impede fluid flow therein.

('*385 Patent*, Col. 13:40-43.)

> 1 The term "capable of is also used in Claims 15, 32, and 38 of the *'385 Patent*.

Under the doctrine of claim differentiation, there is a presumption that when different words or phrases are used in separate claims, they are presumed to have different meanings. *See Comark Communications Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed. Cir. 1998)*. There is no dispute between the parties that the **[*6]** phrase "capable of means "having the ability to." (*See* Stipulation Regarding the Court's August 21, 2006 Order Re: Claim Construction of the "Multiply Folded" Term, Docket Item No. 928.) An object may be "capable of multiply folding upon itself, even if it is not intentionally and specifically made in a way that would cause it to multiply fold. Thus, "capable of is a broader term than "adapted to."

The definition asserted by Defendant Cordis, namely "suitable for" is similar to "capable of." That is, a device

could be suitable for multiply folding upon itself, without being intentionally and specifically made in a way that would cause it to multiply fold. Moreover, Defendant's proposed definition of "suitable for" does not follow from a plain dictionary definition of the word "adapt." Widely accepted dictionary definitions of "adapt" are "to make fit (as for a specific new use or situation)," (Merriam-Webster's Collegiate Dictionary 13 (10th ed. 1998)), and "to make suitable to a specific use or situation." American Heritage College Dictionary 15 (3d ed. 1993). No dictionary that Defendant has cited defines "adapt to" to mean "suitable for."

On the other hand, Plaintiffs' proposed **[*7]** definition of "configured to" embraces the concept of a device intentionally and specifically made to act in a certain way. A widely accepted dictionary definition of the word "configure" means "[t]o design, arrange, set up, or shape with a view to specific applications or uses." American Heritage Dictionary 386 (4th ed. 2000). The written description of the *'498* patent supports the definition of "configured to" because it discloses embodiments in which specific types of materials and wire dimensions are used to make coils that act in certain ways. (*'498* Patent, Col. 9:6-13.)

III. CONCLUSION

The Court construes **"adapted to"** to mean **"configured to."**

Dated: December 20, 2006

JAMES WARE

United tates District Judge